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Paper No. 6

NIXON & VANDERHYE
1100 NORTH GLEBE RD., 8TH FLOOR
ARLINGTON VA 22201-4714

In re Application of
Yamasaki et al.
Application No. 08/696,988
Filed: August 16, 1996
Attorney Docket No. 249-88

In re Application of
Yamasaki et al.
Application No. 10/084,615
Filed: January 29, 2001
Attorney Docket No. 249-159

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OFFICE OF PETITIONS

DECISION GRANTING
PETITION

This is a decision on petition under 37 CFR § 1.53(e), filed on February 28, 2002, and resubmitted by facsimile transmission on May 30, 2002, requesting that an improper Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) be treated as an application under 37 CFR § 1.53(b) and be accorded a filing date of January 29, 2001.

On October 25, 2000, a Notice of Allowance and Issue Fee Due and a Notice of Allowability were mailed in application No. 08/696,988, which set a three (3) month statutory period for reply. On January 29, 2001, applicants submitted a request for a CPA under 37 CFR § 1.53(d) based on prior application No. 08/696,988, 63 pages of specification, claims and abstract, a preliminary amendment, an IDS and a copy of the declaration, as evidenced by the postcard receipt submitted on May 30, 2002. The Office notes that at the time the CPA was filed CPA practice no longer applied to applications, other than design applications, if the prior application was filed on or after May 29, 2000.¹ Accordingly, the CPA request was improper because the prior application was filed on or after May 29, 2000.²

¹ An earlier CPA was filed in application No. 08/696,988 on August 3, 2000. Thus, 37 CFR 1.53(d)(1)(i) does not permit the filing of a further CPA.

² Effective July 14, 2003, the Office eliminated CPA practice as to utility and plant applications. See *Elimination of Continued Prosecution*

Application Nos. 08/696,988 and 10/084,615

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new 37 CFR § 1.114.

A CPA must be filed before the payment of the issue fee in the prior application. See 37 CFR § 1.53(d)(1)(ii)(A). Thus, the CPA is improper because the issue fee was paid before the CPA request was filed. It is noted that the CPA request was filed on January 29, 2001, while the prior application was pending.

On February 28, 2002, applicants filed the present petition. Applicants requested that the improper CPA be converted to an application under 37 CFR § 1.53(b).

The petition is granted.

The application under 37 CFR § 1.53(b) has been assigned application No. 10/084,615. However, the Office erroneously accorded application No. 10/084,615 a filing date of February 28, 2002, the date of receipt of the copy of the prior application papers. The filing date of application No. 10/084,615 will be corrected to reflect the proper filing date of January 29, 2001. The CPA request and the preliminary amendment have been removed from the file of application No. 08/696,988 and have been placed in application No. 10/084,615. A copy of the CPA request and a copy of the present petition will be retained in application No. 08/696,988 to complete the record therein.

All further correspondence concerning the application under 37 CFR § 1.53(b) should be directed to application No. 10/084,615 not application No. 08/696,988.

The Office finance records will be corrected to show that applicants paid the \$710.00 basic filing fee in application No. 10/084,615, not in application No. 08/696,988. The \$80.00 claims fee paid on January 29, 2001 in application No. 08/696,988, and the \$130.00 surcharge paid on April 15, 2002 in application No. 10/084,615 are not necessary. The \$80.00 claims fee will be refunded to counsel's Deposit Account. The \$130.00 surcharge will be applied as the \$130.00 petition fee owed for the filing of the present petition. The Office finance records indicate applicants also paid the basic filing fee in application No. 10/084,615. Therefore, the \$740.00 filing fee paid in application 10/084,615 will be credited to counsel's Deposit Account.

Application No. 08/696,988 will be forwarded to Files Repository.

Application No. 10/084,615 will be forwarded to the Office of Initial Patent Examination for processing as an application filed under 37 CFR § 1.53(b), not under 37 CFR § 1.53(d) using the copy

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of the original application papers submitted on February 28, 2002. Additionally, the Office of Initial Patent Examination is directed to correct the filing date of Application No. 10/084,615 to January 29, 2001.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Christina Tartera Donnell at (703) 306-5589.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND.

1 Date of Request: <u>1/2/04</u>		2 Serial/Patent # <u>10/084,615</u>		
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT
<input checked="" type="checkbox"/> Filing		<u>5</u>	<u>5/30/02</u>	\$ <u>740</u>
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No Fee Due (Explanation):				
11 REFUND REQUESTED BY: <u>C.T. Donnell</u> TYPED/PRINTED NAME: <u>C.T. Donnell</u> TITLE: <u>Pet. Atty</u> SIGNATURE: <u>C.T. Donnell</u> PHONE: <u>306-5589</u> OFFICE: <u>4700</u> **** THIS SPACE RESERVED FOR FINANCE USE ONLY **** APPROVED: <u>Office of Finance</u> DATE: <u>1/7/04</u>				

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